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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,146	10/24/2005	Kazuya Sakata	018765-232	3252

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER	
LE, HOA VAN	
ART UNIT	PAPER NUMBER
1795	

NOTIFICATION DATE	DELIVERY MODE
03/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/554,146	SAKATA ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ---.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This application is up for consideration on the merits.

I. Prior art submission on the record has been considered to the extent of the English language as provided.

II. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwa et al (2002/0076637).

Iwa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (B) having a molecular weight of up to 50,000 and a crosslink vinyl resin (A) comprising a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100, 000 and a gel part of up to 50%. The tested ratios of vinyl resins (B)/(A) are 97-93/3-7. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0016 to 0024, 0029 to 0051, Examples. (*) The language "...obtained by...50%" and "(I)...(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (2) the distinct product-by-

process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Iwa et al.

III. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwa et al (2002/0076637) considered in view of Masazumi et al (JP 09-244295 with its machine English language translation as provided by applicants).

Iwa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (B) having a molecular weight of up to 50,000 and a crosslink vinyl resin (A) comprising a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100, 000 and a gel part of up to 50%. The tested ratios of vinyl resins (B)/(A) are 97-93/3-7. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0016 to 0024, 0029 to 0051, Examples. (*) The language "…obtained by…50%" and "(I)…(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are

always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims 1 and 3-6 have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Iwa et al.

Iwa et al do not specify a wide ratio of the resins. However, it is known in the art to use and practice with a wide ratio of the resins to obtain a wise range of an image operation in the art. Evidence can be seen in Masazumi et al at least on paragraphs 0071 and 0075.

Since the above references are all related to resins for toners, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the wide range of resins for a reasonable expectation of obtaining a wide range of an image operation as disclosed, taught, suggested and obtained in Masazumi et al.

IV. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al (2002/0098431).

Fujikawa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (B) having a molecular weight of up to 40,000 and a crosslink vinyl resin (C) comprising a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and having from 0.1% by weight of insoluble matter. The tested ratios of vinyl resins (B)/(C) are 90-95/10-5. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraph 0063 to 0065, 0135 to 0140, 0156 to 0161, 0179 to 0181, Examples. (*) The language "…obtained by…50%" and "(I)…(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Fujikawa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record,

the above claims have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Fujikawa et al.

V. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al (2002/0098431) considered in view of Masazumi et al (JP 09-244295 with its machine English language translation as provided by applicants).

Fujikawa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (B) having a molecular weight of up to 40,000 and a crosslink vinyl resin (C) comprising a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and having from 0.1% by weight of insoluble matter. The tested ratios of vinyl resins (B)/(C) are 90-95/10-5. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraph 0063 to 0065, 0135 to 0140, 0156 to 0161, 0179 to 0181, Examples. (*) The language "…obtained by…50%" and "(I)…(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (C) of Fujikawa et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible

combinations of the teachings and/or suggestions in the applied Fujikawa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims 1 and 3-6 have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Fujikawa et al.

Iwa et al do not specify a wide ratio of the resins. However, it is known in the art to use and practice with a wide ratio of the resins to obtain a wise range of an image operation in the art. Evidence can be seen in Masazumi et al at least on paragraphs 0071 and 0075.

Since the above references are all related to resins for toners, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the wide range of resins for a reasonable expectation of obtaining a wide range of an image operation as disclosed, taught, suggested and obtained in Masazumi et al.

VI. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masazumi et al (JP 09-244295 with its machine English language translation as provided by applicants).

Masazumi et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (A) having a molecular weight of about 50,000 and a crosslink vinyl resin (B) comprising a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 500,000 and having from 0.1% by weight of insoluble matter. Please see the whole disclosure of the applied reference, especially at least on paragraph 0008 to

0013, 0021 to 0022, 0029 to 0033, 0036, and Examples in the machine English Language translation. (*) The language "…obtained by…50%" and "(I)…(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (B) of Masazumi et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (B) of Masazumi et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Masazumi et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Masazumi et al.

VII. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuo et al (JP 09-319140 with its machine English language translation as provided by applicants).

Yasuo et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (A) together with processing steps of making it and a crosslink vinyl resin (B) together with processing steps of making it. Vinyl resin (B) comprises a glycidyl crosslinking agent for making a crosslinking copolymer units of styrene

and acrylic having a molecular weight of up to 100,000. Please see the whole disclosure of the applied reference, especially at least on paragraph 0008 to 0016 and Examples in the machine English Language translation. (*) The language "…obtained by…50%" and "(I)…(L)" is a product by process. Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the product are always made (1) a distinct product for each of all possible applied crosslinking vinyl resins type (B) of Yasuo et al on the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (B) of Yasuo et al on the record. (**) The language "a gel portion…50%", "…vinyl polymer (H)…1,000,000…per 1 kg…","…vinyl polymer (H)…1,000,000…per 1 kg…", "…vinyl polymer (L)…50,000…per 1 kg…","…vinyl polymer (D)…50,000…per 1 kg…", "crosslinking agent (A)…equivalent/100 g" or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Yasuo et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely. In the absence of convincing evidence as clearly pointed out and set forth on the record, the above claims have insufficient reasons for their allowability and are reasonably rendered prima facie obvious by Yasuo et al.

VIII. International Search Report shows that JP-61-163347 is pertinent to all of the instant claims. However, applicants submit its English language Abstract only. It is insufficient to formulate a rejection against any one of the claims. It is considered cumulate for now but will be next in line to be considered and/or applied before any issue of an allowable claim is made. Applicants are requested to

early, timely and candidly provide a pertinent portion or an English language equivalent of the reference on the record for an early consideration and allowance of the instant claims.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/
Primary Examiner, Art Unit 1795

28 February 2006